No. 96-703

Supreme Court, U.S.
FILED
DEC 31 1996
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1996

JIMMY MERCHANT and HERMAN SANTIAGO,

Petitioners,

—v.—

MORRIS LEVY, BIG SEVEN MUSIC CORP., ROULETTE RECORDS, INC., and WINDSWEPT PACIFIC ENTERTAINMENT CO.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF OF RESPONDENT WINDSWEPT PACIFIC ENTERTAINMENT CO. IN OPPOSITION

ALAN L. SHULMAN
Counsel of Record
SCOTT L. BAKER
JONATHAN J. ROSS
SILVERMAN & SHULMAN, P.C.
136 East 57th Street
New York, New York 10022
(212) 758-2020

Counsel for Respondent Windswept Pacific Entertainment, Co.

RULE 29.6 LISTING

The parent company of Respondent Windswept Pacific Entertainment Co. is FujiPacific Music, Inc. Windswept Pacific Entertainment Co. has no nonwholly-owned subsidiaries.

TABLE OF CONTENTS

		PAGE
TABLE OF AUTHORITIES		iv
STATEMENT OF THE CASE		1
SUMMARY OF ARGUMENT		3
REASONS FOR DENYING THE WRIT		5
POINT I	PETITIONERS DID NOT PRESENT *ANY* OF THE PETITION'S ARGUMENTS TO THE COURT OF APPEALS; THEY ARE RAISED HERE FOR THE FIRST TIME	5
POINT II	THE COPYRIGHT STATUTE OF LIMITATIONS IS CONSTITUTIONAL	7
A.	The Court of Appeals' Application of the Copyright Statute of Limitations is Completely Within the Power Conferred Upon Congress by the Constitution	7
B.	The Court of Appeals Ruling Accords With the Plain Meaning of the Statute of Limitations and the Statute's Underlying Policies of Repose	9
C.	The Court of Appeals Ruling Does not Impair the Public's Use of the Copyright Office Records and is Consistent With Established Precedent	12

PAGE

POINT III THE SECOND CIRCUIT'S OPINION IS IN HARMONY WITH THE NINTH AND FIFTH CIRCUITS' RULINGS 13

CONCLUSION 15

TABLE OF AUTHORITIES

Cases	PAGE
Adams v. Woods, 6 U.S. (2 Cranch) 336 (1805).....	11
Adickes v. S.H. Kress & Co., 398 U.S. 144 (1970)	5
Board of Regents v. Tomanio, 446 U.S. 478 (1980)....	8
Caminetti v. United States, 242 U.S. 470 (1917)	9
Campbell v. City of Haverhill, 155 U.S. 610 (1895)...	11
Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989)	4, 10
Denker v. Twentieth Century-Fox Film Corp., 10 N.Y.2d 339 (1961)	10
Eckes v. Card Prices Update, 736 F.2d 859 (2d Cir. 1984)	13
Edward B. Marks Music Corp. v. Wonnell, 61 F. Supp. 722 (S.D.N.Y. 1945)	13
Gaste v. Kaiserman, 863 F.2d 1061 (2d Cir. 1988)	12
Goodman v. Lee, 78 F.3d 1007 (5th Cir.), *cert. denied*, ___ U.S. ___, 117 S. Ct. 166 (1996) .	5, 6, 13, 14
Jackson v. Axton, 25 F.3d 884 (9th Cir. 1994).....	10, 12, 13
Jerry Vogel Music Co. v. Forster Music Publisher, 147 F.2d 614 (2d Cir.), *cert. denied*, 325 U.S. 880 (1945)	13
Merchant v. Levy, 92 F.3d 51 (2d Cir. 1996)	1, 3, 4, 7, 10, 13
Princeton University v. Schmid, 455 U.S. 100 (1982).	14
Sisson v. Ruby, 497 U.S. 358 (1990).....	5

PAGE

Soriano v. United States, 352 U.S. 270 (1957) 8

Stone v. Williams, 970 F.2d 1043 (2d Cir. 1992), *cert. denied*, 508 U.S. 906 (1993) 3, 4

United States v. James, 478 U.S. 597 (1986) 9

United States v. Kubrick, 444 U.S. 111 (1979) 7, 8

United States v. L. A. Tucker Truck Lines, 344 U.S. 33 (1952) 12

United States v. Ortiz, 422 U.S. 891 (1975) 6

United States v. Ron Pair Enterprises, 489 U.S. 235 (1989) 9

United States v. Shabani, 513 U.S. 10, 130 L. Ed. 2d 225 (1994) 12, 13

Whimsicality, Inc. v. Rubie's Costume Co., 891 F.2d 452 (2d Cir. 1989) 13

Zuill v. Shanahan, 80 F.3d 1366 (9th Cir. 1996), *petition for cert. filed*, 65 U.S.L.W. 3085 (U.S. July 10, 1996) (No. 96-119) 4, 7, 9, 10, 13

Constitution

U.S. Const. art. I, § 8, cl. 8 ..... 9, 11

Statutes

17 U.S.C. § 101 10

17 U.S.C. § 106(2) 10

17 U.S.C. § 304(a) 12

17 U.S.C. § 408(d) 12

17 U.S.C. § 507(b) 2, 7, 9

PAGE

17 U.S.C. § 1101(a) 14

17 U.S.C. § 1101(d) 14

Regulations

37 C.F.R. § 201.5 12

37 C.F.R. § 201.7(c)(4)(vi) 12

Rule

Sup. Ct. R. 10 5

Treatise

3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 12.05 (1994) 3

3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 12.11[B] (1996) 12

IN THE

Supreme Court of the United States

OCTOBER TERM, 1996

No. 96-703

JIMMY MERCHANT and HERMAN SANTIAGO,

Petitioners,

—v.—

MORRIS LEVY, BIG SEVEN MUSIC CORP., ROULETTE RECORDS, INC., and WINDSWEPT PACIFIC ENTERTAINMENT CO.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF OF RESPONDENT WINDSWEPT PACIFIC ENTERTAINMENT CO. IN OPPOSITION

Respondent Windswept Pacific Entertainment Co. ("Windswept") respectfully requests that this Court deny the Petition for a writ of certiorari to review the opinion of the United States Court of Appeals for the Second Circuit, reported at 92 F.3d 51 (1996).

STATEMENT OF THE CASE

This action represents petitioners' attempt to procure a copyright interest in the musical composition "Why Do Fools

Fall in Love?" ("FOOLS") based on their claim to have co-authored "FOOLS" with Frank Lymon in 1955. Petitioners waited until 1987, over thirty years after the song's creation, to file their complaint.[1] By that time, many key witnesses had died, including all of the other members of their musical group (the Teenagers) and two other individuals present in the studio when "FOOLS" was recorded. By the 1992 trial, defendant Morris Levy—another critical witness—had also died. Shortly after the jury verdict, Windswept, having purchased the "FOOLS" copyright in 1988, intervened in order to protect its ownership of "FOOLS."[2]

Petitioners mislead by referring to facts and jury findings which were rejected by the district court. For example, the district court set aside the finding that petitioners reasonably refrained commencing suit until December 1984, since the finding was "against the overwhelming weight of the evidence." Appendix to Petition ("App.") 42a-43a.[3] The district court thus held that the copyright statute of limitations[4]

---

[1] In examining petitioners' lengthy delay, the district court found that petitioners were not "reasonably diligent" in attempting to discover whether they had a cause of action, Appendix to Petition ("App.") 58a, their delay was "partially as a result of [their] neglect," App. 62a, and that petitioners "clearly slept on their rights." App. 23a, 55a. Petitioners did not challenge any of these findings on appeal.

[2] The district court held, "Responsibility for failure to join Windswept must be placed squarely with [petitioners]." App. 19a.

[3] The trial judge "express[ed] serious reservations about the truthfulness of Santiago's testimony concerning Levy's [purported 1969] threat," App. 44a n. 15, and found it "inconceivable" that Santiago would not have testified about the threat earlier in the litigation. *Id.* The prior district court judge also questioned petitioners' credibility and warned petitioners that the direct contradictions between petitioners' affidavits and their deposition testimony "come close to being violative of Fed. Rule of Civil Procedure 56(g)," which penalizes parties and attorneys for submitting affidavits in bad faith. App. 59a n. 3.

[4] 17 U.S.C. § 507(b) prohibits the maintenance of a civil action on a claim more than three years after it accrues.

applied to petitioners' ownership claims and that the statute was not tolled. App. 29a, 42-43a, 49a.

Nevertheless, the district court did not bar the declaratory relief. Rather, in apparent reliance on *Stone v. Williams*, 970 F.2d 1043 (2d Cir. 1992), *cert. denied*, 508 U.S. 906 (1993), the district court applied the statute of limitations to limit petitioners' recovery to royalties that accrued within three years of the filing of the complaint.[5] However, the Second Circuit in this case[6] ruled that *Stone*'s holding is limited to its "highly idiosyncratic facts" and that the statute of limitations for a co-authorship claim properly begins to run when the claim first accrues—in this case 1961—and absolutely bars declaratory relief three years thereafter. *Merchant v. Levy*, 92 F.3d 51 (2d Cir. 1996), App. 13a, quoting 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, § 12.05 at 12-108 n. 2.2 (1994). Petitioners now request that this Court review that Court of Appeals decision.

SUMMARY OF ARGUMENT

None of the questions and arguments contrived by petitioners (including their "constitutional" challenge to the Copyright Act's statute of limitations) were raised in the Court of Appeals or district court below. Instead, petitioners took contrary positions with respect to both questions presented. Petitioners' failure to raise any such questions and

---

[5] In *Stone*, an author's purported illegitimate child, whose status as the author's child was allegedly concealed from her for many years, sued to establish her status as a child of the deceased author and her resultant entitlement to the copyright renewals. While the court allowed the claim to be heard, it limited any recovery to royalties received within three years prior to commencement of the action. 970 F.2d at 1049-52.

[6] The distinguished panel consisted of Chief Judge Jon O. Newman and his immediate predecessors as Chief Judge, Senior Circuit Judges James L. Oakes and Wilfred Feinberg.

arguments below independently warrants denial of their Petition.

Petitioners' reference to a "conflict" with the Constitution is mere sophistry. Petitioners improperly juxtapose the jury's determination on the merits, which should never have taken place, with the statute of limitations' bar to petitioners' claims. As the harmonious decisions of the Second Circuit below and the Ninth Circuit in *Zuill v. Shanahan*, 80 F.3d 1366 (9th Cir. 1996), *petition for cert. filed*, 65 U.S.L.W. 3085 (U.S. July 10, 1996) (No. 96-119)[7], make clear, applying the limitations bar does not implicate the merits. It is beyond dispute that Congress may exercise its legislative power to provide for a statute of limitations in connection with an enactment of substantive rights. Indeed, petitioners have not cited a single case to the contrary.

The Second and Ninth Circuits' now-consistent application of the copyright statute of limitations to co-authorship disputes correctly follows this Court's articulation of the Copyright Act's policy of "*predictability and certainty of copyright ownership*," *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 749 (1989) (emphasis supplied), and the well-established principles of repose. The Second Circuit's decision appropriately follows this Court's teaching and "promotes the principles of repose integral to a properly functioning copyright market." *Merchant v. Levy*, 92 F.3d 51, 57 (2d Cir. 1996), App. 14a.

Finally, there is no conflict among the Circuits. The decisions of the Second and Ninth Circuits are now in harmony, and the inapposite Fifth Circuit decision presented by peti-

---

[7] The petition in *Zuill v. Shanahan* was filed prior to the Second Circuit's decision in this case and relies to a great extent upon a perceived conflict with a prior decision of the Second Circuit, *Stone v. Williams*, 970 F.2d 1043 (2d Cir. 1992), *cert. denied*, 508 U.S. 906 (1993). Any perceived conflict between the Second and Ninth Circuits has now been resolved and rendered moot by the Second Circuit's decision in this case.

tioners, *Goodman v. Lee*, 78 F.3d 1007 (5th Cir.), *cert. denied*, ___ U.S. ___, 117 S. Ct. 166 (1996), simply did not construe any statute of limitations in the context of a federal claim for declaration of co-authorship.

Moreover, since there does not appear to be (nor have petitioners posited) any state statute of limitations that would permit the filing of petitioners' twenty-six-year old claim, the second question presented is merely hypothetical, not justiciable. This Court does not have jurisdiction to render advisory opinions on hypothetical questions.

The absence of any conflict or unsettled legal question underscores the total lack of any "compelling reasons" for this Court's review. *See* Sup. Ct. R. 10. Consequently, the Petition should be denied.

REASONS FOR DENYING THE WRIT

POINT I

PETITIONERS DID NOT PRESENT *ANY* OF THE PETITION'S ARGUMENTS TO THE COURT OF APPEALS; THEY ARE RAISED HERE FOR THE FIRST TIME

This Court has consistently held that it will not consider questions not raised or considered on appeal, except in extraordinary cases. *E.g.*, *Sisson v. Ruby*, 497 U.S. 358, 359 n. 1 (1990); *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 148 n. 2 (1970). Despite years of opportunity during which petitioners were represented by five successive sets of lawyers, petitioners have never previously raised a single question or argument contained in their Petition. Petitioners' failure to raise *any* of these questions and arguments before the Court of Appeals (and the district court) warrants denial of the Petition.

Not only did petitioners fail to raise their arguments below, they actually took contrary positions on both questions they present for review. On the first question, petitioners assert that the copyright statute of limitations applies only to infringement actions, repeatedly mislabeling it the "infringement" statute of limitations. On appeal below, however, petitioners rejected just such contention, arguing that "the three year [copyright] statute of limitations applies to *all* civil actions under Title 17," not just infringement actions. Appellees' Brief at 21 n. 5 (emphasis supplied).

As a second reason for granting the writ, petitioners argue that if a statute of limitations applies to their ownership claim, it should be a state statute, alleging that "issues of ownership [should] be governed by state law." Petition at 15. Of course, this argument diametrically contradicts their appellate argument for application of the *federal* copyright statute. In fact, petitioners characterized this action below as one "for a declaratory judgment to establish co-authorship *under copyright legislation.*" Appellees' Brief at 14 (emphasis supplied).[8]

During eight years of litigation, petitioners did not favor any court below with their new arguments. They should not be permitted to visit contrary positions upon this Court for the first time. *See United States v. Ortiz*, 422 U.S. 891, 898 (1975) (Court would not consider issue where petitioners had taken contrary position on appeal).

---

[8] The inapposite decision in *Goodman v. Lee*, 78 F.3d 1007 (5th Cir.), *cert. denied*, ___ U.S. ___, 117 S. Ct. 166 (1996), upon which petitioners vainly rely to support their argument that a "state law" statute of limitations should be applied to the federal Copyright Act ownership claim, was not raised below even though decided over a month before oral argument in this action and over four months before the Court of Appeals rendered its decision. The Petition is not the proper place to first raise it.

Moreover, it is ironic that application of any state statute of limitations, as petitioners urge herein, would likely bar petitioners' claims. *See infra* p. 14.

POINT II

THE COPYRIGHT STATUTE OF LIMITATIONS IS CONSTITUTIONAL

A. The Court of Appeals' Application of the Copyright Statute of Limitations is Completely Within the Power Conferred Upon Congress by the Constitution

Petitioners' newly contrived "constitutional" challenge comes almost forty years after Congress enacted a uniform, three-year statute of limitations to apply in all civil copyright actions, 17 U.S.C. § 507(b), and on the heels of the Second and Ninth Circuits' harmonious application of the statute to bar tardy claims for co-authorship. *See Merchant v. Levy*, 92 F.3d 51 (2d Cir. 1996), App. 1a; *Zuill v. Shanahan*, 80 F.3d 1366 (9th Cir. 1996), *petition for cert. filed*, 65 U.S.L.W. 3085 (U.S. July 10, 1996) (No. 96-119) (*see supra* p. 4 n. 7).

In a weak attempt to justify their constitutional challenge, petitioners improperly juxtapose a jury's findings with the statute of limitations' bar by impliedly arguing that the bar cannot apply until the fact finder determines whether a defendant (or his predecessor) participated in the creation of the song, i.e. a full-blown determination on the merits. Petitioners' challenge fatally ignores the fundamental purposes of statutes of limitations, as this Court has eloquently explained:

> Statutes of limitations, which "are found and approved in all systems of enlightened jurisprudence," represent a pervasive legislative judgment that it is unjust to fail to put the adversary on notice to defend within a specified period of time and that "the right to be free of stale claims in time comes to prevail over the right to prosecute them." These enactments are statutes of repose; and although affording plaintiffs what the legislature deems a reasonable time to present their claims, they protect defendants and the courts from having to deal with

> cases in which the search for truth may be seriously impaired by the loss of evidence, whether by death or disappearance of witnesses, fading memories, disappearance of documents, or otherwise.

United States v. Kubrick, 444 U.S. 111, 117 (1979) (citations omitted). Petitioners' misleading scenario totally eviscerates the statute, which would thereby no longer protect the courts and parties from the dangers of stale claims. The jury finding is irrelevant since the statute's bar should have precluded the very existence of a jury verdict in the first place.

It is well-settled that, like any other claims, constitutional claims may be barred by statutes of limitations. *See, e.g., Board of Regents v. Tomanio*, 446 U.S. 478 (1980); *Soriano v. United States*, 352 U.S. 270 (1957). In *Board of Regents*, this Court reversed, on statute of limitations grounds, holdings of the district court and Court of Appeals that the due process clause of the Fourteenth Amendment entitled respondent to a hearing prior to the denial of her request to obtain a license to practice chiropractic medicine. 446 U.S. 478. Citing "[t]he importance of policies of repose," the Court held that since the statute of limitations barred respondent's claims, the Court did not need to reach the constitutional issue. *Id.* at 487-92. Nor would the *Soriano* Court hear the argument that petitioner's property was taken without just compensation, in violation of the Fifth Amendment, when such claim was barred by a statute of limitations. 352 U.S. 270, 274-75. As the Court reasoned in *Board of Regents*:

> . . . Congress, unless it has spoken to the contrary, did not intend by the mere creation of a "cause of action" or "claim for relief" that any plaintiff filing a complaint would automatically prevail if only the necessary elements of the federal substantive claim for relief could be established.

446 U.S. at 487. Likewise, the framers of the Constitution did not so intend. Tellingly, petitioners have not supported their

argument with any citation of a constitutional challenge to a statute of limitations.

Congress was granted the power to secure for authors copyrights for "limited times." U.S. Const. art. I, § 8, cl. 8. Accordingly, Congress has the authority to determine the conditions and limitations attendant to copyright protection. Congress' enactment of a statute of limitations to govern all civil copyright actions is squarely within the power conferred by the Constitution.

B. The Court of Appeals Ruling Accords With the Plain Meaning of the Statute of Limitations and the Statute's Underlying Policies of Repose

Petitioners ignore the most basic rule of statutory construction: where the terms of a statute are unambiguous, judicial inquiry is complete and the statute's plain meaning should be deemed conclusive. *United States v. Ron Pair Enterprises*, 489 U.S. 235, 241 (1989); *United States v. James*, 478 U.S. 597, 606 (1986). The language of the copyright statute of limitations could not be more obvious, applying to *all* civil actions "maintained under the provisions of this *title*." 17 U.S.C. § 507(b) (emphasis supplied).[9]

Petitioners also ignore the critical policy determinations made by Congress and explained by the Court. In *Zuill v. Shanahan*, the Ninth Circuit recognized the precise policies of repose underlying the copyright statute of limitations. "Copyright, like real estate, lasts a long time, so stability of title has great economic importance." *Zuill*, 80 F.3d at 1370. Both the Second Circuit below and the Ninth Circuit correctly followed this Court's interpretation of the Copyright Act's

---

[9] Petitioners' attempt to convert the word "title" into "chapter" by invoking the headings of Chapter 5 and former Chapter 2 of the Copyright Act is unavailing, since chapter headings are for convenience only and do not affect a statute's meaning. *Caminetti v. United States*, 242 U.S. 470 (1917).

underlying policies: "Congress' paramount goal in revising the 1976 Act [was] enhancing *predictability and certainty of copyright ownership*." *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 749 (1989) (emphasis supplied), *quoted in Zuill*, 80 F.3d at 1370; *see Merchant*, 92 F.3d at 57, App. 14a.

It is absolutely essential to an orderly market for the buying and selling of copyrights in musical works that a purchaser of such copyrights, like Windswept, be able to rely upon the principles of repose inherent in the statute of limitations. Such principles must bar a potential opposing claim to the ownership (and/or authorship) of a musical work registered for copyright where, as in this case, the opposing claimants, with knowledge of their purported authorship and respondents' claims, have delayed over twenty-six years after reaching majority in filing an action on their claim.

If latecomers, like petitioners, can claim and obtain a copyright ownership interest after decades have elapsed, they could then grant rights which would conflict with previously issued exclusive licenses. Such grants would cause a breach of the usual warranties by licensors, destroy the valuable exclusivity bargained for and invested in by licensees, and vitiate licensees' typical reliance on such exclusivity in the creation of "derivative works." *See, e.g., Denker v. Twentieth Century-Fox Film Corp.*, 10 N.Y.2d 339, 345 (1961) (licensee would not make investment in derivative work absent exclusivity); *see also* 17 U.S.C. §§ 101 & 106(2).

The Second Circuit appropriately found that application of the copyright statute of limitations to a co-authorship claim "promotes the principles of repose integral to a properly functioning copyright market." 92 F.3d at 57, App. 14a. *Cf. Jackson v. Axton*, 25 F.3d 884, 889 n. 4 (9th Cir. 1994) (noting same rationale for application of the statute of limitations and laches).

Petitioners' construction—that a claimant should be able to bring a co-authorship claim at any time during a song's copyright life—would encourage putative claimants to delay bringing their claims until key witnesses have died, as petitioners did. Then, a totally innocent defendant transferee may find it difficult, if not impossible, to defend its title—something it might have been able to do handily had the claimant timely sued when the witnesses were alive. Such approach violates all policies of repose underlying the statute of limitations.

This Court has previously rejected an attempt to eliminate the application of a statute of limitations in the context of a patent, which shares the same constitutional underpinning as copyrights. *See* U.S. Const. art. I, § 8, cl. 8. In *Campbell v. City of Haverhill*, 155 U.S. 610, 616-617 (1895), the Court foretold the harmful result of a failure to apply statutes of limitations to patent claims:

> we [would] have the anomaly of a distinct class of actions subject to no limitation whatever,—a class of privileged plaintiffs who, in this particular, are outside the pale of the law, and subject to no limitation of time in which they may institute their actions. The result is that users of patented articles, perhaps innocent of any wrong intention, may be fretted by actions brought against them after all their witnesses are dead, and perhaps after all memory of the transaction is lost to them. This cannot have been within the contemplation of the legislative power. As was said by Chief Justice Marshall in *Adams v. Woods*, [6 U.S.] 2 Cranch, 336, 342 [1805], of a similar statute: "This would be utterly repugnant to the genius of our laws. In a country within which not even treason can be prosecuted after the lapse of three years, it can scarcely be supposed that an individual would remain forever liable to a pecuniary forfeiture."

This reasoning applies with equal force to the instant case and compels denial of the Petition.

C. The Court of Appeals Ruling Does not Impair the Public's Use of the Copyright Office Records and is Consistent With Established Precedent.

Congress vested the Copyright Office with the power to promulgate regulations to allow for correction or amplification of copyright registrations. 17 U.S.C. § 408(d). In accordance with such regulations, petitioners had every opportunity to seek cancellation of the copyright registration on the grounds that the copyright claimant was incorrect, *see* 37 C.F.R. § 201.7(c)(4)(vi), or to file a supplementary registration to correct any purported error in the original registration, *see* 37 C.F.R. § 201.5. Instead, as the district court found, petitioners "clearly slept on their rights." App. 55a. Having chosen not to register their claims or otherwise correct the Copyright Office records, they should not now be heard to use the alleged inaccuracy of such records as a basis for seeking this Court's review.[10] Moreover, the statutory presumption of validity accorded to copyright registration certificates is *rebuttable*, merely ordering the burden of proof when a copyright's validity is questioned. 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 12.11[B] (1996); *Gaste v. Kaiserman*, 863 F.2d 1061 (2d Cir. 1988).

Petitioners' misleading reliance on an unspecified "century of precedent" is disingenuous at best, since none of the precedent cited by petitioners discusses time limitations.[11] Petitioners also miscite *Jackson v. Axton* as an example of a

---

[10] The issues raised by petitioners with respect to the authorship records of the Copyright Office vis-a-vis the duration of copyright are totally irrelevant. As a pre-1978 copyright, the renewal term of "FOOLS" is 47 years and is unaffected by the author's life. 17 U.S.C. § 304(a).

[11] It is axiomatic that decisions which do not discuss issues are not considered precedent on those issues. *United States v. L. A. Tucker Truck Lines*, 344 U.S. 33, 38 (1952); *see United States v. Shabani*, 513 U.S. 10,

court limiting co-authorship claims "only by equitable considerations." The Ninth Circuit expressly did not reject the statute of limitations; the court simply did not need to consider the statute since the case presented such a straightforward example of laches, *see* 25 F.3d at 887 n. 2, a point specifically cited by petitioners below. Appellees' Brief at 20.

POINT III

THE SECOND CIRCUIT'S OPINION IS IN HARMONY WITH THE NINTH AND FIFTH CIRCUITS' RULINGS

Despite petitioners' misleading contentions that the Second Circuit's decision is "contrary" to and in "conflict" with *Goodman v. Lee*, 78 F.3d 1007 (5th Cir.), *cert. denied*, ___ U.S. ___, 117 S. Ct. 166 (1996), the decisions present no inconsistency whatsoever, let alone a conflict worthy of this Court's intervention. Any difference in outcome between the cases is not due to any legal disagreement, but rather a stark factual difference—the federal ownership claim in *Goodman* was *timely*, while petitioners' claim was not.

Petitioners' claim accrued in 1961, the year they reached majority and were thus charged with knowledge of their claim. *Merchant v. Levy*, 92 F.3d 51, 55, App. 12a. The ownership claim in *Zuill v. Shanahan*, 80 F.3d 51 (9th Cir. 1996), *petition for cert. filed*, 65 U.S.L.W. 3085 (U.S. July 10, 1996) (No. 96-119), accrued four years before commencement of the action. 80 F.3d at 1368-69. Since the threshold co-authorship claims were barred in these two cases, neither the Second nor

---

___, 130 L. Ed. 2d 225, 231 (1994). The cases cited by petitioners did not consider statutes of limitations and are not precedent as to the limitations issue: *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 456 (2d Cir. 1989); *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984); *Jerry Vogel Music Co. v. Forster Music Publisher*, 147 F.2d 614 (2d Cir.), *cert. denied*, 325 U.S. 880 (1945); *Edward B. Marks Music Corp. v. Wonnell*, 61 F. Supp. 722 (S.D.N.Y. 1945).

Ninth Circuits had any reason to discuss which statute would have applied to the subsidiary accounting relief had the ownership claim been timely.[12]

Goodman's ownership claim, on the other hand, *was* timely. Specifically, Goodman filed her action within approximately one year of the time her ownership claim accrued.[13] 78 F.3d at 1010. Thus, there was no need for the court to analyze any statute of limitations in the context of the declaratory relief, *only* the resultant accounting relief. *Goodman* plainly did *not* hold that a state statute of limitations governs the *ownership* claim. Accordingly, *Goodman* does not conflict with the appellate rulings in either this case or *Zuill*.

Finally, even if a state statute applied in this case, petitioners do not explain how they could possibly avoid the bar of any such statute. Windswept is unaware of any state statute of limitations which would countenance petitioners' twenty-six-year delay. Consequently, petitioners have presented a *hypothetical* rather than a *justiciable* question to the Court, thus depriving it of jurisdiction to consider such question. This Court does "not sit to decide hypothetical issues or to give advisory opinions about issues as to which there are not adverse parties before" it. *Princeton University v. Schmid*, 455 U.S. 100, 102 (1982) (dismissing appeal).

---

[12] Contrary to petitioners' rhetoric concerning the newly enacted Chapter 11 of the Copyright Act, there was no "deliberate choice" to confine the statute of limitations to infringement actions only. In fact, any claims brought pursuant to Chapter 11, which neither discusses nor excludes application of the copyright statute of limitations, *see* 17 U.S.C. § 1101(a) & (d), would be subject to the limitations bar which applies to all actions maintained under title 17 of the United States Code.

[13] The *Goodman* complaint was filed in 1985. Goodman "did not know or should not have known" until 1984 that defendant co-author had listed himself as the sole author on the copyright registration. 78 F.3d at 1010.

CONCLUSION

For all of the foregoing reasons, the Petition for a writ of certiorari should be denied.

Respectfully submitted,

ALAN L. SHULMAN
Counsel of Record
SCOTT L. BAKER
JONATHAN J. ROSS
SILVERMAN & SHULMAN, P.C.
136 East 57th Street
New York, New York 10022
(212) 758-2020

Counsel for Respondent
Windswept Pacific
Entertainment Co.